

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE**

RONALD A. KATZ TECHNOLOGY  
LICENSING, L.P.,

Plaintiff,

v.

TD BANKNORTH INC., *et al.*,

Defendants.

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C.A. No. 06-544 (GMS)

**COMERICA'S MOTION TO STAY ACTION  
PENDING THE U.S. PATENT AND TRADEMARK  
OFFICE'S RE-EXAMINATION OF PLAINTIFF'S PATENTS**

Paul J. Lockwood, I.D. No. 3369  
SKADDEN, ARPS, SLATE,  
MEAGHER & FLOM LLP  
One Rodney Square, P.O. Box 636  
Wilmington, DE 19899  
Tel.: (302) 651-3000  
Fax: (302) 651-3001

Daniel A. DeVito  
Guy Perry  
Marti A. Johnson  
SKADDEN, ARPS, SLATE,  
MEAGHER & FLOM LLP  
New York, NY 10036  
Tel.: (212) 735-3000  
Fax: (212) 735-2000

Dated: December 27, 2006

Defendants Comerica Incorporated, Comerica Bank & Trust, National Association, and Comerica Securities, Inc. (collectively, "Comerica") hereby move the Court to stay this action in its entirety pending the conclusion of reexamination proceedings by the United States Patent and Trademark Office of plaintiff's patents. By this motion, Comerica incorporates herein by reference the Motion to Stay filed by Qwest Defendants in Civil Action No. 06-546 (GMS) on Monday, December 18, 2006, and the memorandum and declaration in support (C.A. No. 06-546 (GMS), D.I. 80-82)

On September 1, 2006, plaintiff filed five actions in this District<sup>1</sup> accusing a total of ninety-five defendants of infringing one or more of twenty-six U.S. Patents. Plaintiff has asserted 19 patents<sup>2</sup> in this action including 12 against Comerica.<sup>3</sup>

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<sup>1</sup> *Ronald A. Katz Technology Licensing, L.P. v. Reliant Energy, Inc., et al.* (Civil Action No. 1:06-cv-00543), *Ronald A. Katz Technology Licensing, L.P. v. TD Banknorth, Inc., et al.* (Civil Action No. 1:06-cv-00544), *Ronald A. Katz Technology Licensing, L.P. v. Ahold USA, Inc., et al.* (Civil Action No. 1:06-cv-0545), *Ronald A. Katz Technology Licensing, L.P. v. Time Warner Cable, Inc., et al.* (Civil Action No. 1:06-cv-0546), and *Ronald A. Katz Technology Licensing, L.P. v. American International Group, Inc., et al.* (Civil Action No. 1:06cv-00547).

<sup>2</sup> The patents asserted in this action are U.S. Patent Nos. 4,792,968; 4,930,150; 5,128,984; 5,251,252; 5,351,285; 5,684,863; 5,851,551; 5,828,734; 5,898,762; 5,917,893; 5,974,120; 6,035,021; 6,148,065; 6,335,965; 6,349,134; 6,424,703; 6,434,223; 6,512,415; and 6,678,360.

<sup>3</sup> Those patents asserted against Comerica are U.S. Patent Nos. 4,792,968; 4,930,150; 5,128,984; 5,251,252; 5,351,285; 5,684,863; 5,851,551; 5,828,734; 5,898,762; 5,974,120; 6,349,134; and 6,434,223.

Currently, ten of plaintiff's patents are involved in reexamination proceedings before the United States Patent and Trademark Office.<sup>4</sup> Of the ten patents currently in reexamination, plaintiff has asserted six against Comerica. In addition, since many of Plaintiff's patents are related to each other and involve very similar technology, it is likely that Plaintiff's other patents will be affected by the results of the currently pending reexamination proceedings.

For all the reasons cited in Defendant Qwest's Motion to Stay and supporting Memorandum and Declaration incorporated herein by reference, Comerica respectfully requests that the Court stay this action in its entirety pending the completion of all of the reexamination proceedings by the United States Patent and Trademark Office involving Plaintiff's U.S. Patents that have been asserted in this action as well as other related but unasserted patents. Specifically, this motion to stay should be granted because (1) plaintiff will not be prejudiced, much less unduly prejudiced by such a stay; (2) such a stay will simplify the proceedings as a result of the findings of the reexamination proceedings and thus conserve this Court's and the parties' resources relating to the investigation, discovery, analysis, and construction related to patent claims which are likely to be amended or even cancelled during reexamination; and (3) this

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<sup>4</sup> The RAKTL patents currently in reexamination proceedings are U.S. Patent Nos. 5,255,309; 5,259,023; 5,351,285; 5,561,707; 5,684,863; 5,787,156; 5,815,551; 5,828,734; 6,292,547; 6,434,223; and 5,974,120. An eleventh patent, U.S. Patent No. 5,128,984, has been submitted to the United States Patent and Trademark Office for re-examination, but the United States Patent and Trademark Office has not yet acted on this request.

action has not progressed past the initial pleading stage, discovery has not yet begun, and no trial date has been set.

For all of these reasons, Comerica respectfully requests that this Court stay this action in its entirety pending completion of all of the reexamination proceedings by the United States Patent and Trademark Office involving plaintiff's U.S. Patents that have been asserted in this action and other related but unasserted patents. A proposed form order is attached.

Plaintiff's counsel has been contacting and counsel has indicated that plaintiff is opposed to the requested stay.

DATED: December 27, 2006

Respectfully submitted,

/s/ Paul J. Lockwood  
Paul J. Lockwood (# 3369)  
SKADDEN, ARPS, SLATE, MEAGHER &  
FLOM LLP  
One Rodney Square  
P.O. Box 636  
Wilmington, DE 19899  
Tel.: (302) 651-3000  
Fax: (302) 651-3001

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SKADDEN, ARPS, SLATE, MEAGHER &  
FLOM LLP  
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Tel.: (212) 735-3000  
Fax: (212) 735-2000

*Attorneys for Defendants  
Comerica Incorporated, Comerica Bank &  
Trust, N.A. and Comerica Securities, Inc.*